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EXAMINER

ASHBURN, STEVEN L

ART UNIT PAPER NUMBER

3714

DATE MAILED: 01/30/2004

18

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/689,510

Applicant(s)

WEBB ET AL.

Examiner

Steven Ashburn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-13 and 15-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-10,12,13 and 38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 15-37 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION***Election/Restrictions***

Applicant's election without traverse of 1, 3, 4, 6-10 and 38 in Paper No. 17 is acknowledged.

The requirement is therefore made FINAL. A complete reply to any final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

mmh Claims 15-37 are remaining as withdrawn.

Claim Rejections - 35 USC § 103

Claims 1, 3, 4, 6-10 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff, U.S. Patent 6,312,334 (Nov. 6, 2001) in view of Schwartz, et al., *The Encyclopedia of TV Game Shows*, 3rd Ed., Checkmark Books (1999) (hereinafter "*Encyclopedia*") and Koza, U.S. Patent 4,582,324 (Apr. 15, 1986).

Yoseloff discloses a gaming device that entices players to risk an initial award in return for the opportunity to receive greater payoff in a second game segment during which players chooses from several masked awards. It suggests basing a gaming device's theme on popular television game shows. *See col. 763-9:8*. For example, one embodiment describes a LET'S MAKE A DEAL® game wherein players risk prizes in return for the chance to select a larger prize a masked behind one of three doors. *See fig. 6, 7; col. 7:18-33*.

Claims 1, 10 and 38: *Yoseloff* teaches the following features of the claims:

- a. An initial award value offered to a player. *See col. 8:46-57, 9:46-67*.
- b. A plurality of masked awards including a second award being an enticement award having a value greater than the value of the initial award, and a third award being a consolation award having a value less than the value of the initial award. *See fig. 7; col. 7:19-35*.

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- c. Enabling the player to keep the initial award or to select another masked award. *See col. 6:35-44, 9:46-67.*

As listed above, *Yoseloff* discloses all the features of the claimed subject matter except the following:

- a. Disclosing the values of the masked awards to players without disclosing the association of each of the values with each masked award.
- b. The initial award being selected from a first pool; the second award being from a second pool and the third award being from a third pool wherein the first, second and third pools are used repeatedly so that repeated play of the game provides information about the ranges of values in the pools.

These features would have been obvious to an artisan at the time of the invention in view of the prior art games discussed below.

Regarding the features directed to disclosing values of masked awards, it is generally known to provide players information about the value of prizes in a game of chance. The disclosure allows players to weigh the risk of forgoing a current value for the chance of winning a larger value. The concept is pervasive in gaming systems. For example, few people would wager \$100 without knowledge of the potential return. This is true whether that return be described as a flat rate (e.g. 1:100) or as a range (e.g. a payout table.) Hence, the general concept of disclosing values of awards to a player without disclosing the outcome in advance is in no way novel or unobvious.

In specific regard to the claimed invention, prior art games of chance describe disclosing the values of the masked awards to players without disclosing the association of each of the values with each masked award. First, the television game show LET'S MAKE A DEAL ("*LMAD*") awarded players prizes and offered the option of risking the initial prizes for one of several hidden prizes. *See Encyclopedia, p. 125.* The hidden awards were selected from a range of prizes including from high value items (e.g. cash or merchandise) and consolation prizes of little value. *See id.* Although players did not

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always know the exact value of the prizes, they knew from experience that the value was within a certain range (e.g. \$5,000 to \$15,000). Similarly, the television game show SALE OF THE CENTURY included a game in which players were awarded an initial prize and given the option to trade the prize to select one of three hidden awards. *See Encyclopedia, p. 192. SOC* differed from *LMAD* in that players were expressly informed of the hidden values, however the players did not know which value was associated with each hidden selection. Thus, as demonstrated by *LMAD* and *SOC*, it is a known for games to provide players with an initial award and entice the player to trade the initial award for the opportunity to select from a plurality of hidden awards in the hopes of obtaining a larger award, but at the risk of receiving a lower award. Moreover, as seen in *SOC*, it is known to disclose the values of the awards without disclosing which hidden selection the value is associated with.

Consequently, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Yoseloff*, wherein a gaming device is based on game shows, to add the feature of disclosing the values of the masked awards to the player without disclosing the association of each of the values with each masked award. As demonstrated *LMAD*, enticing players to risk a current award for the opportunity to win a award the player knows to be larger provides a time-proven way to add excitement and tension to a game of chance. Furthermore, as demonstrated by *SOC*, disclosing the values of the masked awards is a known variation of the technique used in *LMAD* which enhances the game by allowing players to use their knowledge of the potential outcomes to weigh the cost and benefit of risking their current award.

Regarding the feature of selecting award values from different pools, the gaming device suggested by *Yoseloff* in view of *LMAD* and *SOC* describes all the features of the claims except the initial award being selected from a first pool; the second award being from a second pool and the third award being from a third pool wherein the first, second and third pools. Notably, this aspect of the invention is

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distinct from the method of displaying values discussed above. Any number of known method may be used to select values to assign to the awards. Pools are one of the most fundamental.

Use of different pools of awards associated with different ranges of prizes is a familiar notion to both laymen and gaming artisans. For example, games of skill¹ offered at local fairs allow players to select different ranges of prizes from different pools associated with the player's level of success. If a player failed at the game, then the player might receive a prize from a pool containing a range of consolation prizes (i.e. booby prizes) . If a player was partially successful at the game, then the player would receive a prize from a pool containing a range of mid-level prizes. Finally, if the player was fully successful at the game, then the player would receive a prize from a pool containing a range of high level prizes. Hence, it is generally known to select awards from different pools representing different levels of prizes. However, is it known in the art of gaming devices to select awards from different pools containing different ranges of prizes? Definitely. For example, *Koza* discloses a multi-level pool system wherein predetermined game outcomes are selected from different award pools to ensure appropriate distribution of the possible outcomes from each level. *See col. 11:26-31*. A first pool contains low-end awards, a second pool contains a intermediate level awards and a third pool contains high-end awards. *See id.* Notably, *Koza* suggests that other methods of generating outcomes are substitutable for the pool-based system; for example, random selection. *See col. 12:28-31*. In view of *Koza*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming device taught by *Yoseloff*, wherein the player is offered the chance to win a prize from one of three levels including an initial award, a high-level award and a low-level award, to add the feature of the initial award being selected from a first pool; the second award selected from a second pool and the third award selected from a third pool as alternate means to select game awards. As taught by *Koza*, selection from multiple pools is a known means of generating random outcomes in gaming devices and is useful in games with multi-level award to ensure appropriate distribution of the possible outcomes from each level.

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Consequently, for all the reasons given above the claims are unpatentable because they would have been obvious to an artisan at a time prior to the invention when the prior art taken as a whole.

Claims 2 and 11 *Yoseloff* additionally teaches means for informing the player of the initial award. *See fig. 5.*

Claims 3-5, 12 and 13, *Yoseloff* additionally teaches means for informing the player of the value of the enticement award and consolation award before the player's selection. *See fig. 7; col. 5:34-43.*

Claim 6, *Yoseloff* additionally teaches a plurality of initial awards. *See fig. 1:26.*

Claims 7, *Yoseloff* additionally teaches a plurality of enticement awards. *See fig. 1:30. (Claim 7)*

Claims 8, *Yoseloff* additionally teaches a plurality of consolation awards. *See fig. 7; col. 7:19-28.*

Claims 9, *Yoseloff* additionally teaches a display device connected to game controller wherein the display reveals a value of at least one award after the player selects an award. *See fig. 7; col. 7:19-63.*

Response to Arguments

Applicant's arguments with respect to claims 1, 3, 4, 6-10, 12, 13 and 38 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments against the combination of *Yoseloff* in view of *Koza* have been fully considered but they are not persuasive. In response to applicant's argument that *Koza* cannot be combined

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with *Yoseloff*, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, *Yoseloff* discloses a selection game with award values selected from different levels of awards. See col. 7:19-35. *Koza* discloses a game in which award values are selected from different levels of prizes contained in different pools. See col. 11:25-64. One of ordinary skill in the art of gaming would be aware of similar pool-based methods for selecting awards from different level pools. For example, it is notoriously well known that fairground games offer pools of prizes containing awards which are selected based on the level of a player's performance. If a player was failed at the game, then player might receive a prize from a pool containing a range of consolation prizes (i.e. booby prizes). If a player was partially successful at the game, then the player would receive a prize from a pool containing a range of mid-level prizes. Finally, if the player was fully successful at the game, then the player would receive a prize from a pool containing a range of high level prizes. The feature is fundamental. It is not limited to *Koza*. *Koza* exemplifies the feature being incorporated into a gaming machine. Consequently, when the prior art is taken as a whole by one of ordinary skill in the art at the time of the invention, it suggests a gaming device in which different awards are selected from different pools.

Prior Art, Not Relied On

The following prior art of record is not relied upon but is considered pertinent to applicant's disclosure:

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'Let's Make a Deal –TV Series – TV Tome', <<http://www.tvtome.com/tvtome/-servlet/ShowMainServlet/showid-5457>> (July 8, 2003) discloses additional information about games played on *LMAD*.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Ashburn whose telephone number is 703 305 3543. The examiner can normally be reached on Monday thru Friday, 8:00 AM to 4:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Hughes can be reached on 703-308-1806. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1148.

s.a.



MARK SAGER
PRIMARY EXAMINER